

REMARKS

Claims 1-3, 5-42, 44 and 46-67 are currently pending in the subject application and are presently under consideration. Claims 1, 15, 24, 30, 32, 34, 37, 38, 40, 42, 44, 46, 51, and 59 have been amended as shown on pages 2-16 of the Reply. Claim 35 and 47 has been cancelled.

Applicant's representative thanks Examiner Huynh for the courtesies extended during the telephonic interview conducted on February 21, 2008. During the interview, the participants discussed the proposed amendments to the claims intended to more clearly distinguish the claims over the cited art references. The Examiner made a number of suggestions for improved clarity, which have been incorporated into the present claim set. The Examiner also indicated that he would consider the arguments and reexamine the cited references upon receipt of the Reply. It should be noted that a number of additional features have been added to the originally proposed amended claim set after the interview was conducted. It is believed that these new features, in addition to those previously discussed with the Examiner, clearly distinguish the present invention from the references cited by the Examiner.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 40-42, 44, 51-57, 59-66 Under 35 U.S.C. §102(b)

Claims 40-42, 44, 51-57, 59-66 stand rejected under 35 U.S.C. §102(b) as being anticipated by E208. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. E208 does not teach or suggest each and ever feature set forth in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject claims relate to a system and method for providing program criteria representing audio-visual programming to facilitate recording the associated audio-visual programs. Tokens representing the audio-visual content can be stored in a token database located on a server and can be transmitted to a remote user computer by the server. The selection of a token to be delivered to a user can be based on selection criteria provided by the user. Upon receipt of a token, the user can in turn send the received token to a recording device to facilitate recording the associated program. Tokens can be freely exchanged between users *via* electronic means such as e-mail. A user who receives a token either from the server or from another user can send the token to his or her own recording system to effect recording of the audio-visual program. In this way, a token associated with an audio-visual program can be sent to multiple recording devices to facilitate recording of the associated program on a plurality of recording devices. Tokens can also represent *segments* of audio-visual content, and these tokens can be used to selectively combine the associated segments of audio-visual content based on demographics of the user requesting the tokens, including but not limited to the user's age. In particular, amended independent claim 40 recites, *a server operable to receive a plurality of tokens, each token having data identifying at least one of a user and the recording system and identifying a plurality of segments of program data associated with an audio-visual program, the server being operable to communicate program data, based on the token, to a programmable recording system to effect programming of the recording system to record the audio-visual program, the programmable recording system utilizes the plurality of tokens to **selectively combine at least two of the plurality of program segments based at least in part upon viewing characteristics of a client system, viewing characteristics of the client system comprising at least the age of viewer.***

Contrary to the Examiner's assertions, E208 and its incorporated references do not disclose these aspects of the subject claims. E208 relates to an interactive television program guide system that affords remote access to program guide features. A remote program guide access device allows a user to remotely connect to interactive program guide equipment and thereby access the functions of the program guide equipment from a remote location. The Examiner cites several sections of E208 relating to remotely

configuring *user preferences* for a program guide system, and remotely scheduling multiple programs (called “super-programs” in the cited reference), but none of these indicated sections disclose or suggest *selectively combining two or more program segments based at least on the age of a viewer*. With particular regard to the super-programs disclosed in E988, and cited by the Examiner as reading on these features, it is noted that paragraph [0178] of E988 discloses that the programs to be included and combined into a super-program sequence are explicitly selected by the user without regard for the user’s age or any other user demographic.

Similarly, amended independent claim 42 recites, *a programmable recording system that utilizes tokens associated with the at least two program segments to combine the at least two program segments based at least in part upon viewing characteristics of a client system, the viewing characteristics of the client system comprising at least demographic data of the user associated with the client system*. As notes *supra*, the cited reference does not disclose such selective combination of program segments.

In addition to the features already discuss, the subject claims also recite that a user can be presented with customized advertisements selected in accordance with the user’s profile information or previous program selections. To this end, the user’s program selections can be tracked, and advertisements deemed to be of interest to the user based on the tracked program selections can be inserted between program segments for viewing. To this end, amended independent claim 42 goes on to recite, *the programmable recording system stores advertisements that are selectively inserted between the program segments, the advertisements are selected based at least on the tracked user selections*. E208 does not disclose selective presentation of advertisements based on a user’s selection of programs, as recited in this independent claim.

Providing further detail on the functionality of tokens, the subject claims disclose that invocation of a token by a user can display a graphical user interface (GUI) for accessing various functions of the token. The GUI can include embedded controls, such as a RECORD control to facilitate programming an associated recording device to record the program identified by the token, and a SEND control for transmitting the token to an e-mail address associated with another user. Users who receive a token from another user can subsequently used the received token to program their own recording devices.

Such features can provide for easy exchangeability of tokens independently of the central audio-visual content provider. In particular, amended independent claim 44 recites, *a RECORD control embedded in the selectable display portion that effects programming of a first recording system to record the audio-visual program represented by the token; and a SEND control embedded in the selectable display portion that facilitates e-mailing the token to any valid e-mail address, e-mailing the token allows the recipient of the token to effect programming a second recording system to record the audio-visual program.* Although E208 allows an owner of a recording device to effect recording of a program on that device from a remote computer, the cited art nowhere suggest that program information can be e-mailed from a first user to a second user to facilitate recording the associated program on the second user's recording device. Rather, the program guide data disclosed in the cited art is exchanged exclusively between a user's remote program guide access device and that user's program guide equipment, and is not described as being e-mailed to or employed by users other than the owner of the remote access device.

Furthermore, amended independent claim 51 recites, *selectively combining at least two of the plurality of tokens based at least in part upon viewing characteristics of at least one user associated with the remote computer, the viewing characteristics comprising at least demographic data of the user,* and as already discussed, the cited reference does not disclose such aspects.

Reciting similar features to those previously discussed, amended claim 59 recites, *selectively combining tokens associated with at least two of the plurality of program segments based at least in part upon viewing characteristics of the user, viewing characteristics comprising at least the age of user; and transmitting the tokens to the user via a communication link, the received tokens utilized by the user to effect recording of the audio-visual program on a recording device and operable to be transmitted by the first user to an e-mail address associated with a second user.* E208 does not disclose selective combination of program segments represented by disparate tokens based at least on the age of a viewer, as noted *supra*. Nor does the cited reference disclose a token that can be both utilized by a user to effect recording of an audio-visual program represented by the token and transmitted to a second user *via* e-mail. As discussed above, E208 only

discloses transmission of program guide information between a user's remote access device and the user's own recording equipment, and nowhere discloses e-mailing any type of program guide information to a disparate user, much less e-mailing a token that can be used by the second user to effect recording of the program on the second user's own equipment.

In view of at least the foregoing, it is respectfully submitted that E208 and its associated references do not teach or suggest each and every feature set forth in amended independent claims 40, 42, 44, 51, and 59 (and all claims depending there from), and as such fails to anticipate the subject invention. It is therefore requested that this rejection be withdrawn.

II. Rejection of Claims 58 and 67 Under 35 U.S.C. §102(e)

Claims 58 and 67 stand rejected under 35 U.S.C. §102(e) as being anticipated by E208. However, claim 58 depends from amended independent claim 51, and claim 67 depends from amended independent claim 59. As noted in the previous section in the Reply, E208 does not disclose all aspects of those independent claims. It is therefore respectfully requested that this rejection be withdrawn with respect to claims 58 and 67.

III. Rejection of Claims 1-3, 5-11, 15-21, 24-25, 27-36, 38-39, 46-50 Under 35 U.S.C. §103(a)

Claims 1-3, 5-11, 15-21, 24-25, 27-36, 38-39, 46-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over E208 in view of Boyer, *et al.* (US 7,165,098 B1). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither E208 nor Boyer, *et al.* teach or suggest all features set forth in the subject claims.

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

Amended independent claim 1 recites, *the remote computer utilizing at least two tokens to selectively combine at least two program segments based at least in part upon viewing characteristics of one or more users at the remote computer, the viewing characteristics comprising at least an age of the one or more users*. As discussed *supra*, E208 fails to disclose such selective combination based at least on the age of a user. Boyer, *et al.*, which relates to an on-line television schedule application that allows users to personalize the manner in which programming information is presented, fails to remedy these deficiencies of E208.

Furthermore, amended independent claim 15 recites, *the at least one token is utilized to program a first recording device to record the audio-visual program represented by the token by transferring the at least one token to from the first computer to the first recording device; and the at least one token is transferable from the first computer to the second computer as an e-mail attachment, the e-mailed token utilized to program a second recording device to record the audio-visual program by transferring the e-mailed token from the second computer to the second recording device*. As discussed in the previous section of the Reply, E208 does not teach or suggest a token that can be both utilized by a user to record a program, and transmitted to a second user’s e-mail address to facilitate recording of the program on the second user’s own equipment. Although, as the Examiner indicates, E208 teaches that program guide information can be transferred between a *remote access device* and *television program guide equipment* using Simple Mail Transfer Protocol (SMTP), the cited reference does not disclose that such information can be sent between computers independently of the television guide equipment *via* traditional e-mail. Likewise, Boyer, *et al.*, while disclosing that scheduling information can be delivered to a user *via* e-mail, specifies that

this information consists only of *text-only schedule information*, and as such cannot be utilized by a user to effect recording of a television program.

Similarly, amended independent claim 24 recites, *means for transmitting a selected token to a first computer in response to a query from a user identifying program selection criteria; means for **transmitting a copy of the token as an e-mail attachment from the first computer to a second computer**; means for utilizing the token to program a first recording device to record the audio-visual program by **transferring the token from the first computer to the first recording device**; and means for **utilizing the copy of the token to program a second recording device to record the audio-visual program by transferring the copy of the token from the second computer to the second recording device***. Again, neither cited reference teaches or suggests a token that can be both utilized by a user to effect recording of an audio-visual program and transmitted to a second user *via* e-mail for the same purpose, independently of the recording equipment.

The subject claims also disclose that, in the event that no stored tokens match the selection criteria provided by a user, the selection criteria can be stored in a database together with information identifying the user. Should a token matching the selection criteria later become available, a notification, or the token itself, can be delivered to the user. To this end, amended independent claim 24 further recites, *means for storing the program selection criteria information in a database when none of the stored tokens match the selection criteria and subsequently sending a notification to the user at a later time when a token matching the stored selection criteria becomes available*. Neither E208 nor Boyer, *et al.* disclose these aspects of the claims.

Additionally, the subject claims disclose that tokens can be tracked in order to provide an indication of the number of times the token has been downloaded to a user, as well as the number of times the token has been transmitted *between users*. Tracking these statistics can provide an accurate measure of the popularity of a program represented by a token. In particular, amended independent claim 24 goes on to recite, *means for tracking the number of times the token is transmitted to a user in response to a query from the user and the number of times the token is transmitted between users*. None of the cited references teach or suggest tracking the number of times a token has

been downloaded to a user, or the number of times the token has been transmitted *between users*.

Furthermore, amended independent claim 30 recites, *utilizing the at least two tokens to selectively combine the at least two program segments based at least in part upon viewing characteristics of one or more users of the second computer, the viewing characteristics comprising at least demographic data of the one or more users*. E208 is silent regarding such selective combination of program segments based on demographic data of a user, as previously noted, and Boyer, *et al.* fails to cure this shortcoming.

Additionally, amended independent claim 32 recites, *e-mailing the token residing on the second computer to an e-mail address associated with a first recording device; ...utilizing the e-mailed token to program the first recording device to record the audio or visual program represented by the token; e-mailing a copy of the token from the second computer to an e-mail address associated with a second user; and utilizing the copy of the token e-mailed to the second user to program a second recording device to record the audio or visual program represented by the token, the second recording device is programmed by e-mailing the token to an e-mail address associated with the second recording device*. As already discussed in connection with several other independent claims, the cited references do not disclose a token with this type of exchangeability that can be used to program respective recording devices associated with the disparate users.

With further regard to exchangeability of tokens, the subject claims disclose that a user can configure a list of trusted e-mail addresses in connection with the token-based system, such that tokens received from any of the trusted e-mail addresses can be automatically utilized to program the recipient's recording device to record the associated program. If a token is received from an e-mail address that is absent from the recipient's list of trusted e-mail addresses, the system can require verification from the recipient before using the token to program the user's recording device. In particular, amended independent claim 46 recites, *e-mailing the token from the first client computer to an e-mail address associated with a second user; **determining if the e-mailed token was received from an e-mail address that has been authorized by the second user;** **automatically sending the e-mailed token to a second recording device associated with the second user to effect recording of the program content without requesting***

confirmation from the second user when the token is received from an e-mail address that has been authorized by the second user; and requesting authorization from the second user to effect recording of the program content on the second recording device when the token is received from an e-mail address that has not been authorized by the second user. The Examiner contends that McKissick, *et al.* anticipates this type of token authentication, citing in particular that reference's inclusion of a block list that allows a user to block reminder messages sent by specific senders. However, the reminder messages of McKissick, *et al.* are merely messages transmitted from a sender to a recipient to remind the recipient of the impending broadcast of a particular problem. The recipient can then interact with the message to tune his or her set top receiver to the appropriate channel. These messages are not utilized to effect recording of a program, and therefore are not analogous to the tokens described in the subject claims. More specifically, McKissick, *et al.* fails to disclose automatically utilizing a received token to effect recording of an associated program *without requesting confirmation from the recipient* when the token is received from a trusted e-mail address, and *otherwise requesting confirmation* from the recipient when the token is received from an e-mail address that is not on the recipient's trusted list.

In view of at least the foregoing, it is respectfully submitted that E208, alone or in combination with Boyer, *et al.*, does not teach or suggest all features set forth in amended independent claims 1, 15, 24, 30, 32, and 46 (and all claims depending there from), and as such fails to make obvious applicant's claimed subject matter. Consequently, this rejection should be withdrawn.

IV. Rejection of Claims 12-14, 22-23, 26, 37 Under 35 U.S.C. §103(a)

Claims 12-14, 22-23, 26, 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over E208 in view of Boyer, *et al.* as applied to claim 11, 15, 25, or 36 above, and further in view of Knudson, *et al.* (US 6,536,041). However, claims 12-14 depend from amended independent claim 1, claims 22-23 depend from amended independent claim 15, claim 26 depends from amended independent claim 24, and claim 37 depends from amended independent claim 32. Moreover, Knudson, *et al.* does not remedy the aforementioned deficiencies of E208 and Boyer, *et al.* with respect to those

independent claims. Specifically, Knudson, *et al.* relates to display of real-time data (sports scores, news, *etc.*) on an interactive television program guide. However, although Knudson, *et al.* discloses that a viewer can initiate a recording of a television program *via* a controllable ticker on the viewer's television display, the cited reference in no way suggests that recording is effected through the use of tokens that can be *sent to other users* to facilitate recording of programs on other recording devices. As such, Knudson, *et al.* fails to cure the shortcomings of the previously discussed references with respect to the subject independent claims, and consequently this rejection should be withdrawn with respect to claims 12-14, 22-23, 26, and 37.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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